

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN S. ZAWALICK

Appeal No. 2002-1763
Application No. 09/267,149

ON BRIEF

Before, OWENS, TIMM and JEFFREY T. SMITH, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 45-51 which are all the claims pending in the application.
We have jurisdiction under 35 U.S.C. § 134.

THE CLAIMED SUBJECT MATTER

Claim 45, the only independent claim, is illustrative of the subject matter on appeal:

45. A method for preserving a petroleum-based liquid product containing atmospheric oxygen in the head space during storage comprising the steps of:

- (a) displacing substantially all atmospheric oxygen from the head space of a container containing said product using an inert gas or blend of inert gases, said gas or said blend being heavier than atmospheric oxygen; and
- (b) dispensing inert gas or said blend of inert gases is into said container from an aerosol can; and
- (c) sealing said container for storage after said atmospheric oxygen has been displaced from said container with said gas or said blend.

THE EVIDENCE

As evidence of unpatentability, the Examiner relies upon the following prior art references:

Zinke	3,878,664	Apr. 22, 1975
Perlman	5,060,823	Oct. 29, 1991
Marano et al. (Marano)	5,452,563	Sep. 26, 1995

THE REJECTIONS

Claims 45-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over: (1) Marano in view of Perlman and (2) Zinke in view of Perlman. We reverse with respect to both rejections for the following reasons.

OPINION

The Examiner bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). To establish a *prima facie* case of obviousness, the Examiner must show some objective teaching in the prior art or otherwise provide a basis to believe that knowledge generally available to those of ordinary skill in the art would have lead those artisans to make the specific combination that was made by the applicant. *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In the present case, such evidence is lacking.

The rejections are based on the modification of the processes of Marano and Zinko. Marano and Zinko describe processes of displacing ambient air in the headspace of a container with a gaseous protective blanket of inert gas. As acknowledged by the Examiner, neither Marano nor Zinko describe using an aerosol can to dispense the inert gas. Therefore, the Examiner turns to Perlman. According to the Examiner it would have been obvious to use the aerosol can as taught by Perlman in the process of Marano or Zinko for dispensing the inert gas required by Marano and Zinko.

The problem is that the Examiner fails to provide a plausible reason or motivation to make the combination. Perlman employs an aerosol can, but uses the can to dispense a liquid solution into a receptacle. We agree with Appellant that the focus of Perlman is on maintaining the sterility of the liquid that is dispensed (Brief at 10). The primary references are directed to delivering inert gas to the headspace of a container to displace air and provide a blanket of inert

gas over the liquid product in the container. There is little connection between the process of Perlman and the processes of the primary references. A suggestion to use an aerosol can to dispense inert gas does not flow from the disclosure of Perlman and the Examiner provides no other basis for finding a suggestion within the prior art as a whole. In our view, the motivation for the examiner's stated rejection appears to come from the description of Appellant's invention in their specification and is based on impermissible hindsight. Such a use of Appellant's specification is improper. *See W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

We further note that the claims are directed to a method of preserving a petroleum-based liquid product and require displacing substantially all atmospheric oxygen from the headspace of a container containing the petroleum-based liquid product. There is no suggestion, particularly for the combination of Zinke with Perlman, to apply the gas displacement process to a container of petroleum-based liquid product.

We conclude that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the subject matter of claims 45-51.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 45-51 under 35 U.S.C. § 103(a) is reversed.

REVERSED

TERRY J. OWENS
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

Appeal No. 2002-1763
Application No. 09/267,149

Page 6

STEVEN S. ZAWALICK
PO BOX 13838
SAN LUIS OBISPO, CA 93406